

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Hague System Overview

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Hague System in 25 Words or Less...

- Mechanism for
 - registering an industrial design
 - having effect in one or more Contracting Parties (CP)
 - filing a single international application
 - single language
 - single set of fees

What is an industrial design?

“In a legal sense, an industrial design constitutes the ornamental or aesthetic aspect of an article.

An industrial design may consist of three dimensional features, such as the shape of an article, or two dimensional features, such as patterns, lines or color.”

-From the website of the World Intellectual Property Organization (WIPO) at www.wipo.int/hague/en/

Analogous WIPO Treaties

- Patent Cooperation Treaty (**PCT**)
 - Mechanism for filing a *single international application* to obtain protection for **utility** inventions in designated CPs
- **Madrid**
 - Mechanism for filing a *single international application* to obtain **trademark** protection in designated CPs

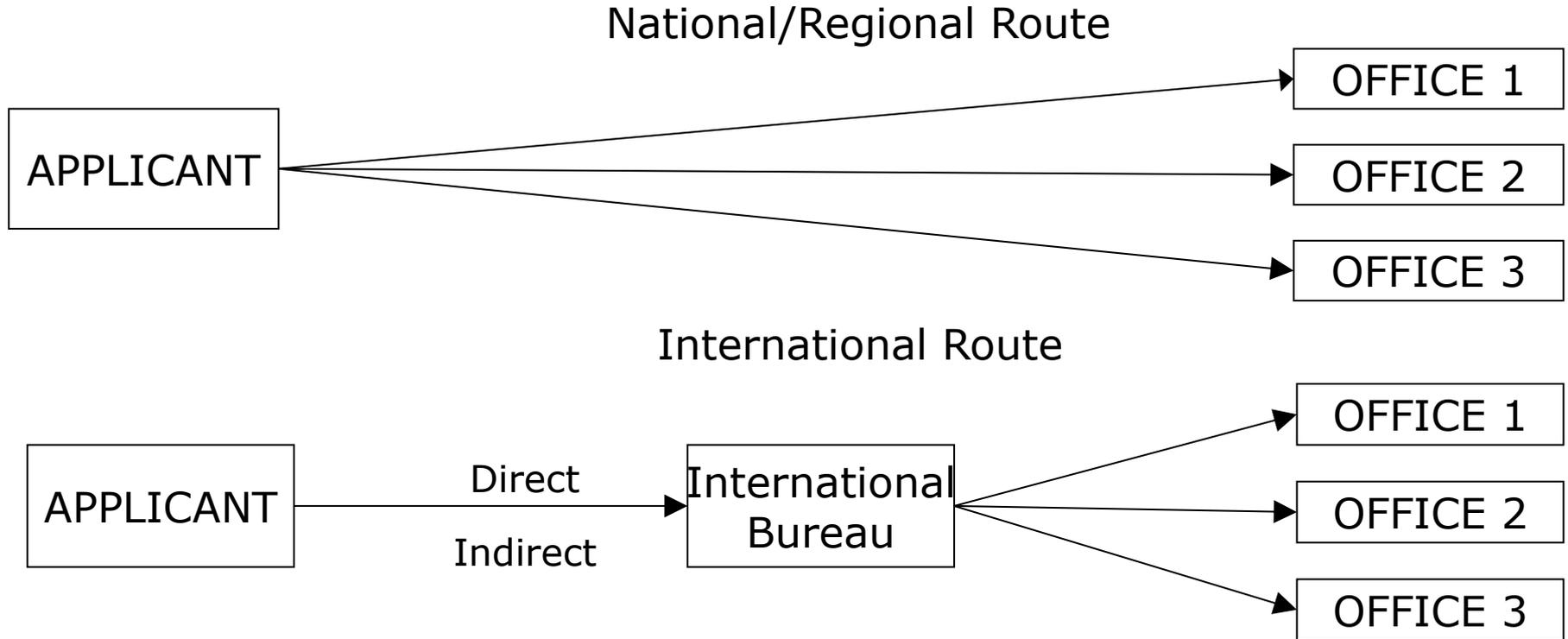
Analogous WIPO Treaties

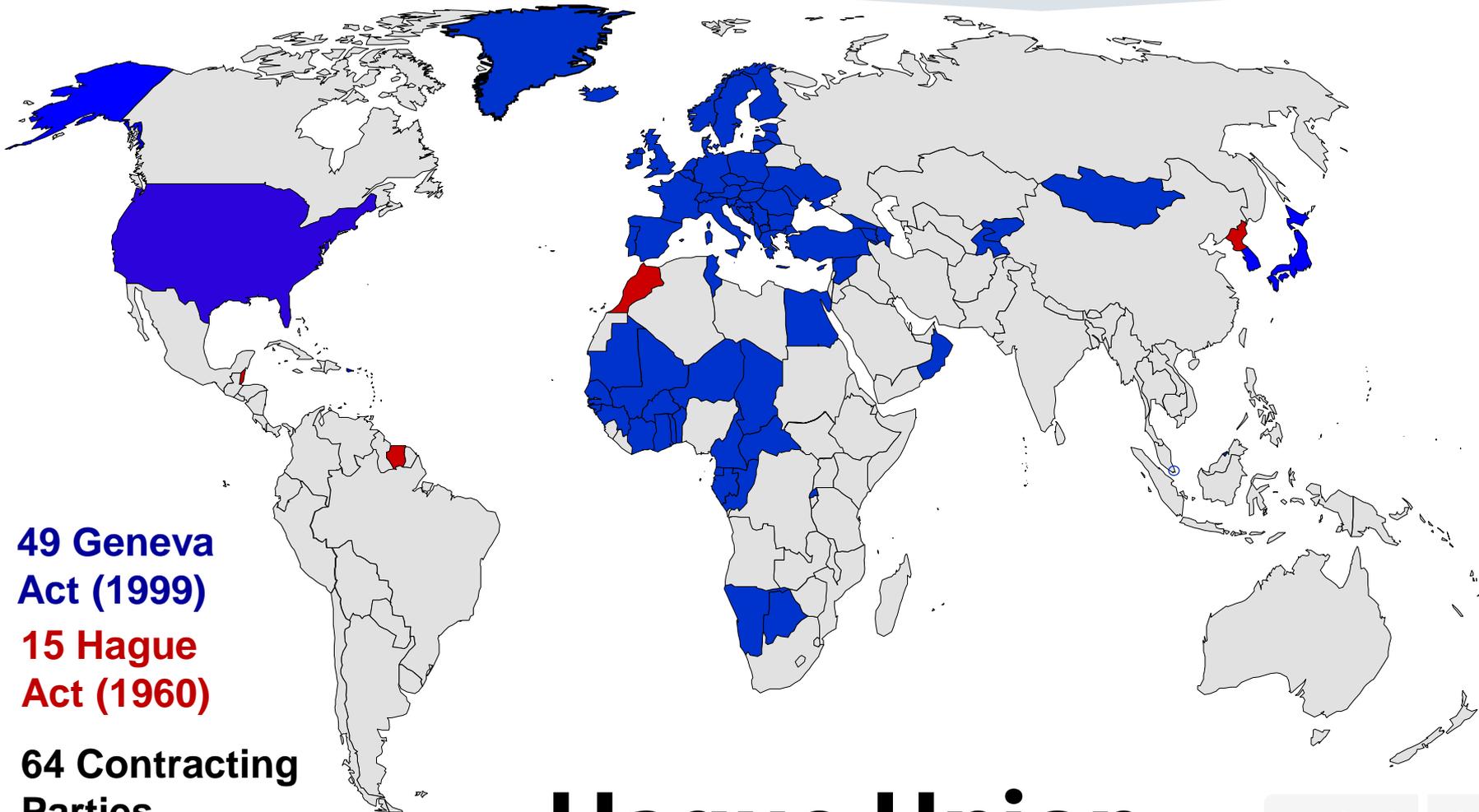
- Comparison with **PCT & Madrid**:
 - Like **PCT & Madrid**: a *procedural* treaty
 - Like **Madrid**, **unlike PCT**:
 - a registration treaty
 - CPs individually designated
 - **Unlike Madrid**
 - No basic application required
 - No “office of origin role” – WIPO is central shop
 - Self -designation possible

History of the Hague Agreement

- **Hague Agreement of 1925**
 - No longer applied
- **London Act (1934)**
 - “frozen” as of January 1, 2010
- **Hague Act (1960)**
 - Euro-centric membership
 - New members are not joining this act
- **Geneva Act (1999)**
 - Took effect with respect to the **United States** on **May 13, 2015**

Filings: National vs Hague





**49 Geneva
Act (1999)**

**15 Hague
Act (1960)**

**64 Contracting
Parties**

Hague Union



August 12, 2015

What Hague does not cover

- Hague Agreement is primarily a *procedural* treaty, accordingly certain issues are not addressed:
 - Conditions for protection
 - Rights that result from protection
- These issues are left to the laws of each of the Contracting Parties

Geneva Act Legal Framework



- Articles
 - Articles 1-34
- Common Regulations
 - Rules 1-37
- Administrative Instructions
 - Nine Parts
 - Sections 101-902
- Laws & Regulations of Contracting Parties

U.S. Statutes & Regulations Implementing the Geneva Act

- 35 U.S.C. chapter 38
 - 35 U.S.C. 381-390
- 37 CFR part 1, subpart I
 - §§ 1.1001-1.1071

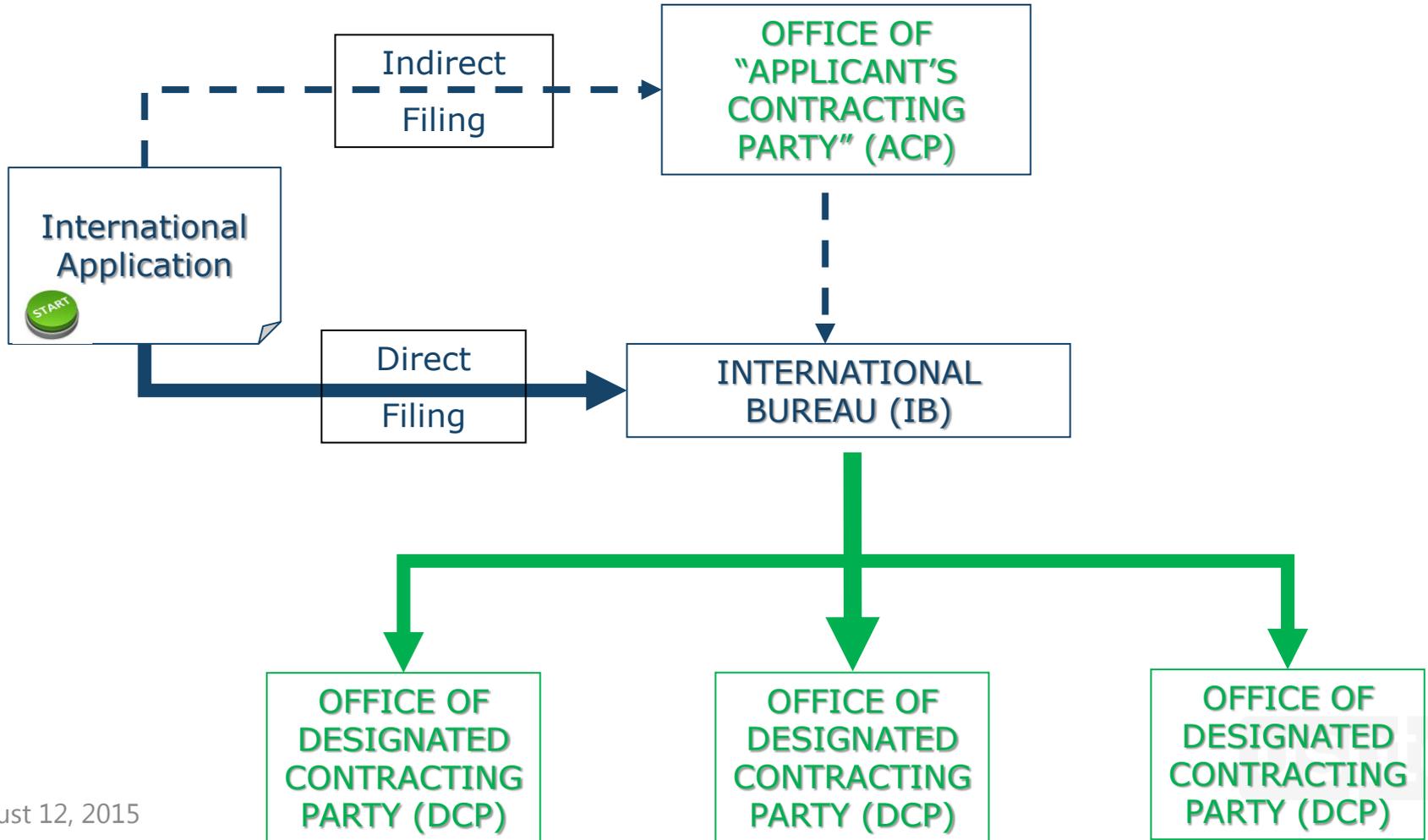
Some Basic Principles

- The Hague Agreement is a **closed** system
 - Applicant must have a **connection** with a CP to file
- To designate a CP, that CP and the CP to which applicant has a **connection must be bound by the same Act**
- Where there is more than one common Act with respect to a designated CP, the **latest Act applies**

Some Basic Principles

- Under Article 14, international registration has the *same effect* in designated CPs as:
 - A **regularly-filed application** from the date of international registration
 - A **grant of protection** (if **no refusal**) at the **latest** of:
 - 6 months from WIPO publication
 - Where the CP has made a Rule 18 declaration, the time specified in that declaration

Hague System Procedure



Roles in the Hague Process

Three Main Actors:

1. Office of Indirect Filing
2. International Bureau (WIPO)
3. Office of a Designated Contracting Party

Roles in the Process

- **Office of Indirect Filing**
 - Limited review... essentially a pass-through office
 - Accords a “receipt” date
 - May require payment of a transmittal fee
 - Many CPs do not provide for filing through their office

Roles in the Process

- **International Bureau (WIPO)**
 - Examines formalities
 - Records in the International Register
 - Issues a Registration Certificate to holder
 - Publishes in WIPO Bulletin in 3 official languages
 - Transmits copies of certain notifications received from CPs to holders
 - Maintains the International Register

Roles in the Process

- **Office of a Designated Contracting Party**
 - Conducts *substantive* examination to the extent required under the CP's law
 - Some CPs republish
 - USPTO will issue a design patent if appropriate (republish)

Quick Statistics

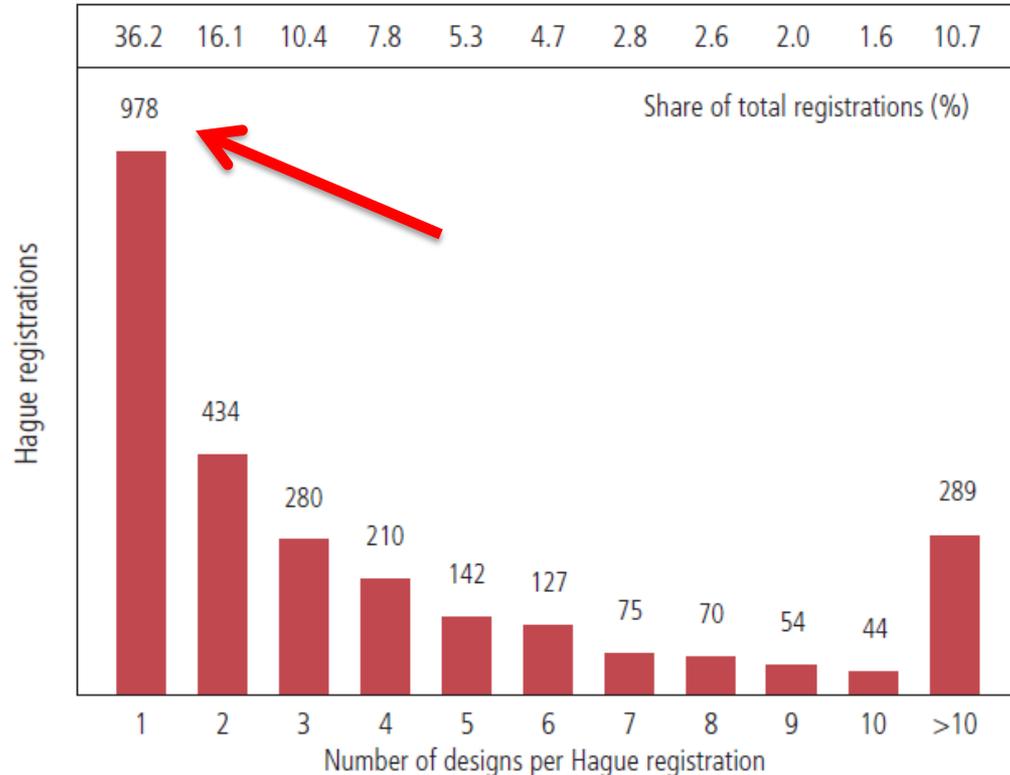
- **Hague System in 2014 ***
 - 2924 International Applications (-2.2%)
 - 14,441 designs (+9.6%)
 - 2703 International Registrations (-1.1%)
 - 13,504 designs (+5.5%)
 - 27,838 International Registrations in force (+2.3%)
 - 116,571 designs (+4.5%)

* *See WIPO 2015 Hague Yearly Review*
http://www.wipo.int/edocs/pubdocs/en/wipo_pub_930_2015.pdf

Quick Statistics

- Distribution of **designs** per international registration in **2014** (**63%** had 3 or less designs).

* *See WIPO 2015 Hague Yearly Review*
http://www.wipo.int/edocs/pubdocs/en/wipo_pub_930_2015.pdf

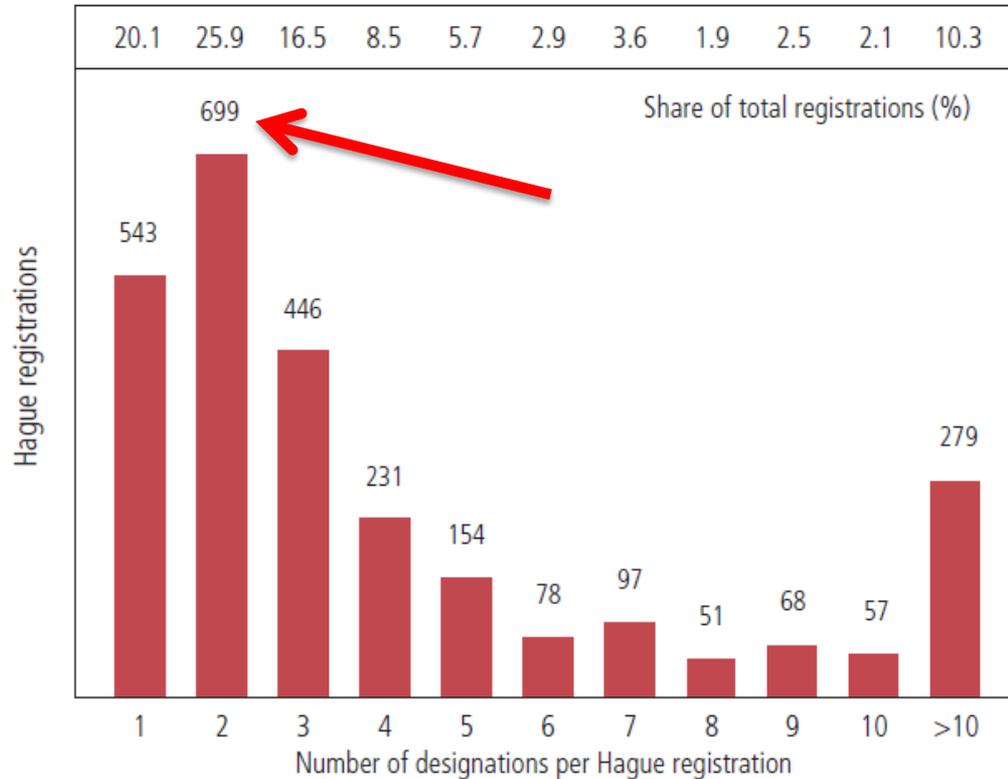


Quick Statistics

- Distribution of **designations** per international registration in 2014
(**63%** had 3 or less designations; EM, CH, TR were top 3).

* See *WIPO 2015 Hague Yearly Review*
http://www.wipo.int/edocs/pubdocs/en/wipo_pub_930_2015.pdf

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International Design Applications:

Who Can File

Where to File

Who can file an International Design Application?

That depends on **where** the international design application is filed....

1. **Directly** with the International Bureau
2. **Indirectly** through an office of indirect filing

To File Directly With the International Bureau

- The applicant must have at least one of the following **connections** with a **Contracting Party** to the Hague Agreement:
 - Nationality
 - Domicile
 - Habitual residence
 - Real and effective industrial or commercial establishment
- If there is more than one applicant, **each** applicant must have a connection to a Contracting Party

To File Through the USPTO as an Office of Indirect Filing

- The applicant must have at least one of the following **connections** to the **United States**:
 - **U.S.** Nationality
 - Domicile in the **U.S.**
 - Habitual residence in the **U.S.**
 - Real and effective industrial or commercial establishment in the **U.S.**
- If more than one applicant, **each** applicant must have a connection to the **United States**

Filing Through the USPTO: What do we review?

- USPTO reviews:
 1. Entitlement to file through the USPTO
 - i. Does applicant have a connection to the U.S.?
 - ii. Is the U.S. applicant's Contracting Party?
 2. Payment of the transmittal fee
 3. National security

Filing Through the USPTO: What do we review?

- If the above 3 conditions **are met**, the USPTO will transmit the application to the IB
 - Applicant will be notified of the transmittal and of the application receipt date
- If the above 3 conditions **are not met**, the USPTO will **not** transmit the application to the IB
 - Applicant will be notified of the reason(s) why transmitted could not be effected

Filing Through the USPTO: Applicant's CP

- To file through the USPTO, the U.S. must be “**applicant's Contracting Party**” (ACP)
 - The ACP is the CP through which applicant derives entitlement to file an IDA, or if there are two or more such CPs, the one indicated as such in the IDA
- Indicate in Box 3 of the official form (DM/1)
- Applies to each applicant

(Article 1 (xiv), Article 4, §1.1012)

Filing Through the USPTO: How to File

- IDAs may be submitted to the USPTO electronically via **EFS-Web** or in **paper** via mail or hand delivery
 - Facsimile transmission of IDAs to the USPTO is prohibited
- IDAs filed in **paper** are subject to an **additional** per page WIPO publication fee
 - Currently, **150** Swiss francs for each page containing a reproduction after the first page

Filing Through the USPTO: How to File

- IDAs filed through EFS-Web **may also be subject to the additional per page publication** fee if the reproductions are not submitted in the prescribed manner
- EFS-Web has been designed to avoid incurring the additional per page publication fee by guiding users to attach reproductions via a special “**Attach Reproductions**” section
 - Permits attachment of single page PDF and JPEG files only
 - A design/view number is associated to each image file uploaded

Filing Through the USPTO: How to File

EFS Unregistered

Unregistered eFilers | Please Read Announcements | Application Data | Attach Documents | Review Documents | Calculate Fees | Confirm & Submit | Pay Fees | Receipt

Attach Documents

A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.
This is the application data associated with your filing. If any information is incorrect, please edit the [Application Data](#)

Title of Invention: Car Window
Applicant Name: John Q Filer
Customer Number or Correspondence Address: 1234
Filed By: John Q. Filer
Attorney Docket Number:
Application Type: International Design Application (Hague) for filing through the USPTO as an office of indirect filing

Attach Documents other than Reproductions

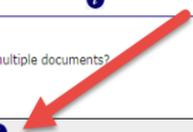
Files to be Submitted	Category	Document Description
1 <input type="button" value="Choose File"/> No file chosen Does your PDF file contain multiple documents? <input type="radio"/> Yes <input checked="" type="radio"/> No	View All Categories	

Attach Reproductions

Instructions: Click the "Browse" button to attach each reproduction. To avoid additional per page publication fees, each reproduction must be submitted as a single page PDF or JPEG file that contains only one reproduction per file. In addition, the numbering of the reproduction should not appear in the image content but rather associated with the PDF or JPEG file via the attaching section below. See <http://www.wipo.int/hague/en/fees/sched.htm>. To add additional views or designs, click the "Add View" or "Add Design" Button. To reorder the sequence of views or designs click the "Move Up" or "Move Down" buttons.

Design 1

Files to be submitted	Document Description
View 1.1 <input type="button" value="Choose File"/> jpg1.jpg	Drawings-only black and white line drawings <input type="button" value="Delete"/> <input type="button" value="Move Down"/> <input type="button" value="Move Up"/>
View 1.2 <input type="button" value="Choose File"/> jpg2.jpeg	Drawings-other than black and white line drawings <input type="button" value="Delete"/> <input type="button" value="Move Down"/> <input type="button" value="Move Up"/>



Filing Through the USPTO: How to File

An EFS-Web Quick Start Guide for filing international design applications through the USPTO is available:

<http://www.uspto.gov/patents-application-process/applying-online/efs-web-guidance-and-resources>

Direct vs. Indirect Filing Considerations

Why file directly with the IB?

- Applicant does not have a U.S. connection but does have a connection with another CP
- IB's E-filing system has robust data checking features
- No transmittal fee is required
- Reduces processing delay and filing date risks associated with an indirect office
- Allows instant payment of WIPO applications fees

However-- a foreign filing license may be needed to file directly with the IB (35 U.S.C. 184)

Direct vs. Indirect Filing Considerations

Why file indirectly through the USPTO?

- No need for a foreign filing license
 - USPTO will review IDA and grant license if appropriate
- Difference in time zones may benefit last minute filers
- May file reproductions in PDF

However-- Each applicant must have a U.S. connection

International Design Applications: **Parts & Contents**

Components of an International Design Application

Main components:

1. “Official form” & Annexes
2. Reproductions
3. Fees

Official form

- The IDA **must** be presented on the “**official form**” signed by the applicant
- The IB established form **DM/1** “Application for International Registration” as an official form

(Rule 7(1), Rule 1(vi), § 1.1022)

Official form

- If applicant's **representative** signs the DM/1 form, a power of attorney appointing that representative in compliance with **Rule 3** should be submitted
- Rule 3 governs appointment before the IB
 - Only **one** representative may be appointed
 - **Cannot** appoint by Customer Number

Annexes

- For submitting required & optional content items for certain designated CPs
- Annexes currently available:
 1. **Annex I:** Oath or declaration of the creator (**US**)
 2. **Annex II:** Document(s) supporting a declaration to the exception to lack of novelty
 3. **Annex III:** Information disclosure statement (**US**)
 4. **Annex IV:** Micro-entity certification (**US**)

Official form and Annexes

The DM/1 Form/Annexes /Instructions are available on WIPO's website at www.wipo.int/hague/en/forms/:

E-filing/Forms

All forms are available in a single MS Word PK-zipped file 

- [Instructions](#) for completing and printing editable PDF forms.

Form	Latest revision	Description	Downloadable paper versions	Online versi
DM/1	June 2015	Application for international registration Annex I Annex II Annex III Annex IV		E-Filing

Contents of an IDA

Three types of content:

1. Mandatory contents
2. Additional mandatory contents
3. Optional contents

(Art. 5, Rule 7, § 1.1021)

Mandatory Content

All IDAs shall include or indicate:

- Prescribed data concerning the applicant
- Basis for applicant's entitlement to file
- Indication of the product(s) that constitute the industrial design or in relation to which the design is to be used
- Designation of at least one CP
- # of designs in the IDA, which may not exceed 100

(See Rule 7(3) for a complete list)

Additional Mandatory Content

IDAs **designating certain CPs** shall include or indicate:

- Any element required by a designated CP under **Article 5(2)**
 - i. Identity of the creator (*RO*)
 - ii. A brief description of the reproduction or of the characteristic features of the industrial design (*RO, SY*)
 - iii. A claim (*US*)
- Any requirement concerning the *applicant* or *creator* by a designated CP under **Rule 8** (*US, FI, IS, HU, GH*)
- **Applicant's CP** (where a 1999 Act CP is designated) (*Rule 7(4)*)

Optional Contents

Optional contents for IDAs include, e.g.:

- A request for **deferred** or **immediate** publication
- The name/address of applicant's representative
- A claim of priority under the Paris Convention
 - ❖ **No** provision for adding a priority claim after filing
 - ❖ **No** provision for submitting the priority document to the IB

(See Rule 7(5) for a complete list)

Optional Contents

Timing of WIPO publication:

- **Default** publication: **6 months** after the date of international registration (or as soon as possible thereafter)
- **Immediate** publication: immediately after registration
- **Deferred** publication: Up to **30 months** from the priority date (or filing date, if no priority), provided:
 - The IDA does not designate a CP that does not permit deferred publication (e.g., U.S.)
 - Some designated CPs may limit the period to < 30 months

(Rule 17)

No Additional Matter

- If the IDA contains any matter other than required or permitted, the IB “shall delete it *ex officio*”
- The IB may dispose of any document other than those required or permitted

(Rule 7(6))

Same Locarno Class

- All the designs in the IDA must belong to the same class of the Locarno Classification

(Rule 7(7))

Contents – U.S. Designated

IDAs **designating the U.S.** must include:

1. A claim
2. Indications concerning the identity of the creator(s)
3. The inventor's oath or declaration
 - WIPO Annex I contains forms for the inventor's declaration and substitute statement specifically tailored for use in IDAs

(§ 1.1021(d))

Contents – U.S. Designated Claim

- Claim:
 - More than one claim is not permitted
 - *the specific wording shall be in formal terms to the ornamental design for the article (specifying name of article) as shown, or as shown and described*

(§1.1025)

Contents – U.S. Designated Claim

12

CLAIM (Applicable to the designation of the **United States of America** only)⁸

Indicate an article in the blank space provided. Only one article shall be indicated, irrespective of the number of industrial designs contained in the present international application.

CLAIM: The ornamental design for as shown and described



If the space provided is not sufficient, check this box and use a continuation sheet.

⁸ If the **United States of America** is designated in item 7, this information is required.

Contents – U.S. Designated Description

- IDAs designating the U.S. must include a specification as prescribed by 35 U.S.C. 112
- Applicants should include a **description of the views** in **Box 10** of the DM/1 form
 - Input a numerical code (1=Perspective; 2=Front; etc....)
 - May be required during the U.S. examination phase if missing
- **Box 9** of the DM/1 form is for providing any additional description
(§§ 1.1024 and 1.1067)

Contents – U.S. Designated Description

9

DESCRIPTION^{4, 5}

Only the characteristic features of the industrial design(s) that appear in (a) reproduction(s) should be described. In addition, matter which is shown in a reproduction but for which protection is not sought may be indicated in the description (and/or by means of dotted or broken lines or coloring in the reproduction). The description can further disclose the operation or possible use of the industrial design as long as it is not technical. Furthermore, the omission of a specific view may be indicated. If the description exceeds 100 words, an additional fee of 2 Swiss francs per word exceeding 100, shall be payable.

.....

.....

.....

.....

.....

If the space provided is not sufficient, check this box and use a continuation sheet.

⁴ If the Syrian Arab Republic is designated, a brief description of the reproduction or of the characteristic features of the industrial design is required.

⁵ If Romania is designated, a brief description of the characteristic features of the design is required.

10

DESCRIPTION OF THE REPRODUCTIONS (LEGENDS)⁶

Associate the number in the margin of your reproduction with the corresponding code:

1 Perspective; **2** Front; **3** Back; **4** Top; **5** Bottom; **6** Left; **7** Right;

9 Unfolded; **10** Exploded; **11** Cross-sectional; **12** Enlarged; **00** Other (limited to 50 characters)

No.	Code	Legend (max 50 characters, where code 00 has been indicated)	No.	Code	Legend (max 50 characters, where code 00 has been indicated)	No.	Code	Legend (max 50 characters, where code 00 has been indicated)

If the space provided is not sufficient, check this box and use a continuation sheet.

⁶ Recommended for a designation of Japan and the United States of America.

Reproductions

- Reproductions shall comply with **Rule 9** and **Part Four** of the *Administrative Instructions* (A.I.)
- WIPO also sets forth technical requirements for reproductions submitted as image files at

http://www.wipo.int/hague/en/how_to/file/prepare.html

(§ 1.1026)

Reproductions

Notable provisions of **Rule 9**:

- Reproductions “*shall be of a quality permitting all the details of the industrial design to be clearly distinguished*” (Rule 9(2))
- A CP may **refuse** on grounds that the reproductions “*are not sufficient to disclose fully the industrial design*” (Rule 9(4))
- A CP may declare that it requires certain specific views (Rule 9(3))
 - Only **JP** and **KR** have made declarations under Rule 9(3)

Reproductions

Some notable provisions of the **A.I.**:

- “may comprise **both** photographs and other graphic representations, in black and white or in **color**” (A.I. 401)
- Shading/hatching permitted (A.I. 404)
- Must be of a “professional standard” (A.I. 404)
- Matter shown but for which protection is not sought may be indicated in the description and/or by dotted or broken lines or **coloring** (A.I. 403)
- Numbering of reproductions, e.g., “1.1, 1.2” (A.I. 405)

International Design Applications: International Bureau Review

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International Bureau (IB) - Formal Examination

- The IB examines the IDA to ensure that it meets the prescribed formal requirements under the treaty and, if appropriate, accords the application a **filing date** and **international registration date**
- If the applicable requirements are not satisfied, the IB will invite applicant to make the required correction(s) within a set time limit

(Article 8, Rule 14)

International Bureau - Formal Examination

- **Failure to timely comply** with the IB invitation will result in **abandonment** of the application or **removal of a designated CP** (for a defect relating to an *additional mandatory content* item)
- Any response to an invitation from the IB **must be filed directly with the IB** and **not** through the USPTO to avoid any loss of rights under Article 8. Follow-on submissions received by the USPTO after the application has been transmitted to the IB are not forwarded to the IB.

(§ 1.1045)

Filing & Registration Dates

- International filing date
- International registration date
- U.S. filing date

International Filing Date

- The filing date of an IDA is governed by Article 9 and Rules 13 & 14

International Filing Date

For IDAs filed directly with the IB, the filing date is:

- the date the IDA is received by the IB
subject to Rule 14(2)

International Filing Date

For IDAs filed **indirectly**, the filing date is:

- the date the IDA is received by the **office of indirect filing**, *subject to Rule 14(2)* and provided the IDA is:
 1. Governed **exclusively** by the Geneva Act, and
 2. **Received by the IB** within **one** month of such receipt date (or **six** months if a security clearance is required; the U.S. requires a security clearance)
- Otherwise, the filing date is the date the IB receives the IDA, *subject to Rule 14(2)*

International Filing Date

Rule 14(2) filing date defects:

- The IDA is not in a prescribed language
 - English, French or Spanish (*Rule 6(1)*)
- The IDA is missing any of the following elements:
 1. An indication that **international registration is sought**
 2. Indications allowing the **identity** of the **applicant** to be established
 3. Indications sufficient to **enable the applicant or representative to be contacted**
 4. A **reproduction** (or specimen as provided by Article 5(1)(iii)) of the industrial design
 5. The **designation** of at least one CP

International Registration Date

The **international registration date** is the later of:

1. The filing date
2. The date of receipt of an element required by a designated CP under Article 5(2)

(Article 10(2))

Filing Date in the United States

- The filing date of an IDA in the **United States** is the **international registration date**
- Applicants may petition under § 1.1023 for review of the U.S. filing date. The petition requires:
 1. A showing that the IDA is entitled to the requested filing date, and
 2. Petition fee (§ 1.17(f))

International Design Applications: Fees

Transmittal Fee

- Payment of a transmittal fee is required if the IDA is filed through the USPTO
 - Amount: **\$120** (no entity-based discount)
 - The IDA will **not** be transmitted to the IB if the transmittal fee is not paid

(§1.1031(a))

WIPO Application Fees

Application fees required by WIPO:

1. Basic fee

- 397 CHF for 1 design; 19 CHF/additional design

2. Publication fee

- 17 CHF/reproduction
- 150 CHF/page of reproduction after 1st page (paper submissions)

3. Designation(s) fee

- Standard (levels 1-3) (42/60/90 CHF)
- Individual (67 chf-733 CHF)
- May also depend on the # of designs

4. Additional word fee if description > 100 words

- 2 CHF/word

(Rules 12(1), 11(2) and 28(1))

WIPO Application Fees

- Amounts are set forth in:
 - *Schedule of Fees*
<http://www.wipo.int/hague/en/fees/sched.htm>
 - *Individual Fees under the Hague Agreement*
<http://www.wipo.int/hague/en/fees/individ-fee.html>
- “Hague System Fee Calculator” is a WIPO tool for calculating application fees
<http://www.wipo.int/hague/en/fees/calculator.jsp>

WIPO Application Fees

Hague System Fee Calculator

Enter the details below to quickly estimate the application or renewal fees in Swiss francs (CHF)

Type:	<input type="text" value="International Application"/>
Date:	<input type="text" value="13.05.2015"/>
Applicant's State of origin (Hague "1960" Act):	<input type="text" value="Not Selected"/>
Applicant's Contracting Party (Geneva "1999" Act):	<input type="text" value="Not Selected"/>
Add the number of industrial designs:	<input type="text" value="1"/>
Add the number of reproduction(s) of the industrial design(s):	<input type="text" value="1"/>
If using the paper application form, add the number of pages of reproductions: (free if you use the e-filing interface)	<input type="text" value="0"/>
Add the number of words of description:	<input type="text" value="0"/>
Locarno Classification:(For KR designations only)	<input type="text" value="1"/>
Economic Status : (For US designations only)	<input type="text" value="Undiscounted (default)"/>

Select All

Clear All

Continue

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Paying WIPO Application Fees

Paying WIPO through the USPTO:

- Applicants filing indirectly **may** pay WIPO application fees through the USPTO **on or before** the date of payment of the transmittal fee
 - Payment will only be accepted in **U.S. dollars**

Note: fluctuations in currency exchange rates may result in the IB receiving less than the required Swiss currency amount, and the IB may invite the applicant to pay the deficiency

(§ 1.1031(d))

Paying WIPO Application Fees

Applicants are **not** required to pay WIPO application fees through the USPTO

- IB will invite applicant to pay any deficiency
- Later payment of WIPO fees does **not** impact the filing date or international registration date

Paying WIPO Application Fees

Paying WIPO directly:

- Modes of payment: credit card, WIPO current account, bank and postal transfer
- Can pay online via WIPO's
 - E-filing system (if filing directly with WIPO)
 - E-Payment system (after WIPO sends in an irregularity letter)
- Can include authorization to charge a WIPO current account on the DM/1 form

For further information, see:

<http://www.wipo.int/about-wipo/en/finance/hague.html#payments>

U.S. Designation Fee

- U.S. individual designation fee consists of two parts:
 1. A **first part** due on filing
 2. A **second part** (issue fee) due within the time period set in a notice of allowance

First Part U.S. Designation Fee

- **First part**= 733 CHF
 - Approx. equivalent to the *combined* U.S. dollar amounts for the filing, search & examination fees for a regular U.S. design application
 - Discounted 50% for small and 75% for micro entities
 - **Box 18** of the DM/1 form includes a check box to indicate entity status (Micro entities must still submit a micro entity certification via Annex IV)

Second Part U.S. Designation Fee (Issue Fee)

- If the USPTO determines that the applicant is entitled to a patent, a **Notice of Allowance** (PTOL-85 (Hague)) will be sent specifying the amount of the **second part** of the U.S. designation fee (issue fee)
- Fee can be paid:
 - **Directly to USPTO** - in U.S. dollars in the amount stated in the Notice of Allowance
 - **To WIPO**– in Swiss Francs in the amount specified on web site of WIPO

Second Part U.S. Designation Fee (Issue Fee)

- Small/micro entities must verify entitlement to such entity status prior to paying the issue fee
- If no longer entitled to small/micro entity status, a notification of loss of entitlement **must be filed directly with the USPTO** prior to or at the time of paying the issue fee
 - Further information is set forth in the Notice of Allowance

The International Registration has published... **now what?**

Consider Whether Certain Documents Need to be Filed with Designed CPs

- **NO** submission/fee is required to trigger examination
- There may still be a need to file certain documents with the designated CP, e.g.:
 - **Priority document**
 - JP & KR, for example, require such to be filed within 3 months from WIPO publication
 - Declaration and/or supporting documents **for an exception to lack of novelty**
 - JP, for example, requires such to be filed within 30 days from WIPO publication

Consider Whether Certain Documents Need to File with Designed CPs

- Many CPs require local counsel to file documents with their office
- If **U.S.** is designated, consider need to file:
 - Certified copy of foreign priority document
 - ADS to claim domestic benefit
 - IDS (filed within 3 months from WIPO publication does not require a fee or § 1.97(e) statement)
 - Change of correspondence address
 - Customer Number with e-Office action delivery will result in earlier notification of any refusal

What to expect?

- Some CPs do **not** examine and may not communicate any notification regarding a grant of protection
- Some non-examining CPs:
 - **OAPI**: grant of protection begins from the date of international registration
 - **Bosnia and Herzegovina**: grant of protection begins from the date of WIPO publication

What to expect?

- **Examining** CPs will send a **Refusal** if the requirements under their national/regional law are not met
- Degree of examination varies
 - Many examining CPs do not examine for novelty

What to expect?

- Generally no requirement for an examining CP to send notice that protection is granted if it determines no refusal is warranted
 - Exceptions:
 - The design was amended before the CP
 - Rules 18(1)(c)(i) or (ii) “extensions” apply to the CP
- Some offices (e.g., OHIM) still send notice of a grant of protection

Refusals

- Refusals are communicated **directly to the IB**, which must transmit a copy to the holder “*without delay*”
- Time period for communicating the Refusal to the IB:
 - **6 months** from WIPO publication, or
 - **12 months** (if the CP makes a **Rule 18(1)(b)** declaration)
 - Such declaration may include statements under **Rule 18(1)(c)(ii)** (excusing unintentional delay by the CP) and **Rule 18(1)(c)(i)** (setting a later time at which protection is granted in the CP)

CPs Having > 6 Month Refusal Period

Rule 18(1)(b)	Rule 18(1)(c)(i)	Rule 18(1)(c)(ii)
Finland		
Iceland		
Japan		X
Kyrgyzstan		
Lithuania		
Republic of Korea		X
Moldova		
Romania		
Spain	X	
Syria		
Turkey	X	
United States	X	X

Following a Refusal

- Any reply to a Refusal must be filed directly with the office sending the Refusal and not through the IB
 - Available remedies and procedures (e.g., possibility of re-examination, review, appeal) are governed by the CP's applicable law
- Subsequent communications by the CP are generally not communicated through the IB
 - Exceptions: Any withdrawal of the refusal/Statement of Grant of Protection

Treatment of Multiple Designs

A CP may declare under **Article 13** that its law requires that designs that are subject of the **same application** conform to a requirement of:

- unity of design
- unity of protection or unity of use
- belonging to the same set or composition of items, or
- only one independent and distinct design may be claimed in a single application

Treatment of Multiple Designs

- An Art. 13 declaration permits the CP to refuse the effects of international registration pending compliance with the applicable requirement
- Art. 13 declarations made by:
 - United States, Japan, Singapore, Romania, Estonia, Kyrgyzstan, Syria, Tajikistan

Treatment of Multiple Designs

- **United States**

- An application found to contain “patentably distinct” designs will be subject to a **restriction requirement** in the form of a **refusal**.
- Applicant may cancel designs to leave only one patentably distinct design in the application and pursue protection for the cancelled design(s) by filing a **divisional** application

Treatment of Multiple Designs

- **Japan**
 - **No refusal** on the **grounds** that the application contains **multiple designs**
 - National application number is given to each design
 - Notification of Refusal or Statement of Grant of Protection is prepared for each design

Grant of Protection in CPs

- The start date and term of a grant of protection varies by CP:
- **United States**
 - Protection begins: On the date of **issuance of a U.S. patent**
 - Provisional rights also be available from the date of WIPO publication
 - Term: **15** years from issuance
 - Fixed term- no renewal or maintenance fees required

Grant of Protection in CPs

- **European Union**

- Protection begins: On the **date of international registration** (if no refusal or refusal is withdrawn)
- Max Term: **25 years** (Must renew at 5 year periods)

- **Republic of Korea**

- Protection begins: On the date of the **statement of grant of protection**
- Max Term: **20 years** (Must renew at 5 year periods)

Grant of Protection in CPs

- **Japan**
 - Protection begins: On the date of on which the **establishment of a design right in Japan is given**
 - Max Term: **20 years** (Must renew every 5 years)

Renewals

- International registrations are renewed through the IB
 - Basic fee + designation fee(s)
 - due by the date of expiration of the IR
 - Payable online via WIPO’s “E-Renewal” service
- Renewal is not required to maintain a **U.S. design patent in force**

